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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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08/964,257

11/04/1997

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23872 7590 05/24/2007  
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EXAMINER

NGUYEN, MADELEINE ANH VINH

ART UNIT

PAPER NUMBER

2625

MAIL DATE

DELIVERY MODE

05/24/2007

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<p align="center"><b>Advisory Action</b> <b>Before the Filing of an Appeal Brief</b></p>	<b>Application No.</b> 08/964,257	<b>Applicant(s)</b> TERASHIMA ET AL.	
	<b>Examiner</b> Madeleine AV Nguyen	<b>Art Unit</b> 2625	

**--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

THE REPLY FILED 30 April 2007 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☒ The period for reply expires 6 months from the mailing date of the final rejection.  
 b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### NOTICE OF APPEAL

2. ☒ The Notice of Appeal was filed on 01 May 2007. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

#### AMENDMENTS

3. ☒ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because  
 (a) ☒ They raise new issues that would require further consideration and/or search (see NOTE below);  
 (b) ☐ They raise the issue of new matter (see NOTE below);  
 (c) ☒ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or  
 (d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: \_\_\_\_\_. (See 37 CFR 1.116 and 41.33(a)).


4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).  
 5. ☐ Applicant's reply has overcome the following rejection(s): \_\_\_\_\_.  
 6. ☐ Newly proposed or amended claim(s) \_\_\_\_\_ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).  
 7. ☐ For purposes of appeal, the proposed amendment(s): a) ☐ will not be entered, or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.  
 The status of the claim(s) is (or will be) as follows:  
 Claim(s) allowed: \_\_\_\_\_.  
 Claim(s) objected to: \_\_\_\_\_.  
 Claim(s) rejected: \_\_\_\_\_.  
 Claim(s) withdrawn from consideration: \_\_\_\_\_.

#### AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).  
 9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing of good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).  
 10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

#### REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because: see attachment.  
 12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08) Paper No(s). \_\_\_\_\_.  
 13. ☐ Other: \_\_\_\_\_.

  
 Madeleine AV Nguyen  
 Primary Examiner  
 Art Unit: 2625

## **DETAILED ACTION**

### ***Response to Arguments***

1. Applicant's arguments filed on April 30, 2007 have been fully considered but they are not persuasive for the following reasons:

A. Applicant remarks that Tajima clearly shows that the scanner part 2 or any surface thereof does not define the second sheet transporting path when the scanner part 2 is mounted to the printer device 3. Tajima fails to provide the advantages that the scanner apparatus to be in direct contact with the sheet being scanned, and the pick up roller and the feeding roller located within the scanner apparatus to be in direct contact with the paper. Tajima et al teaches that the housing of the scanner part 2 is in contact with the printer body 3 and does not define or form any part of the second transporting sheet path.

As stated in the claims, the second sheet transporting path is defined by a surface of the scanner and a surface of the base apparatus, which faces to the scanner in case where the scanner is mounted on the base apparatus to that a sheet travels downward along all length. Tajima teaches a sheet transporting path is defined by a surface of the scanner and a surface of the base apparatus. From Fig.5, we can see the surface of the scanner facing the surface of the base facing the original paper X. In other words, the original sheet is below the surface of the base while the surface of the base is below the surface of the scanner. The rotation of rollers 20 and 21 transport the original paper X down from opening 5 to ejection 6. Moreover, in Fig. 6, Tajima further teaches a pair of follow rollers 20 and 21, being contact with the vibration panel 28, becomes rotated clockwise and the original paper X is transported. Thus without the scanner

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facing the base apparatus, there is no second transporting path since there are no rollers to transport the original sheet down the path. Thus the surface of the base apparatus can be defined as the surface below or above the original sheet X and without the surface of the scanner facing the surface of the base apparatus, the original sheet can not be transported down the path and there is no second transporting path. That is the reason why there are 3 holes 80 and 81 for the rollers 20 and 21 to directly contact the original sheet and hole 4 for the image sensor 2a to scan the original sheet X. In addition, Tajima also teaches the same advantages as the present invention since the image sensor 2a can directly scan the original sheet X while the rollers 20 and 21 are in direct contact with the paper X. Therefore, in order to have a second transporting path in Tajima, a surface of the scanner has to face a surface of the base apparatus in order for the original sheet X to be transported by the rollers in the scanner downward.

Besides, it is noted that the claims must be given their broadest reasonable interpretation. During patent examination, the pending claims must be given their broadest reasonable interpretation consistent with the specification. In re Hyatt, 211 F.3d 1367, 1372, 54 USPQ2d 1664, 1667 (Fed. Cir. 2000). Applicant always has the opportunity to amend the claims during prosecution, and broad interpretation by the examiner reduces the possibility that the claim, once issued, will be interpreted more broadly than is justified. In re Prater, 415 F.2d 1393, 1404-05, 162 USPQ 541m 550-51 (CCPA 1969).

B. Concerning claims 10, 19-25, 34-36 and 46-50, Applicant remarks that the references as a whole fail to suggest the combination of features claimed. Further, both Tajima et al and Shimizu fail to disclose a groove receives a protecting member, a pivotal shaft to mount and

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dismount the hand scanner. As such, the references do not suggest the invention and therefore all claims define over the prior art as a whole.

As stated in the office action, it is a matter of well known in the art at the time the invention was made to have a groove in Tajima to hold the hand scanner mounted on the base apparatus or a pivotal shaft. Shimizu teaching is used only to support the well known prior art by teaching a hand-held scanner mounted on a base apparatus having the groove to receive and hold the hand-held scanner and a pivotal shaft. Thus, the test of obviousness is not whether the features of the reference may be bodily incorporated into the other to produce the claimed subject matter but simply what the references make obvious to one of ordinary skill in the art. In re Bozek, 163 USPQ 545, (CCPA 1969); In re Richman 165 USPQ 509, (CCPA 1970); In re Beckum, 169 USPQ 47 (CCPA 1971); In re Sneed, 710 F.2d 1544, 218 USPQ 385. In addition, it is not necessary that the references actually suggest, expressly or in so many words, the changes or improvement that applicant has made. The test for combining references is what the references, as a whole would have suggested to one of ordinary skill in the art. In re Sheckler, 168 UCPQ 716 (CCPA 1971); In re McLaughlin 170 USPQ 209 (CCPA 1971); In re Young 159 USPQ 725 (CCPA 1968).

C. Applicant remarks that Shimizu fails to teach a first and second transporting guide wherein the first transporting guide has a straight guide part and a deflected guide part. Figure 4 shows that the thermal head 41 is not provided at the deflected part of the transporting guide.

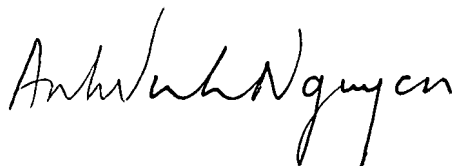
Fig.4 in Shimizu clearly shows that the transporting path starts with a straight guide part and then follows a deflected guide part (col. 4, lines 4-12).

***Conclusion***

2. The final rejection of the claims is maintained.
3. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Madeleine AV Nguyen whose telephone number is 571 272-7466. The examiner can normally be reached on Tuesday-Thursday 12:30-6:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Edward L. Coles can be reached on 571 272-7402. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



Madeleine AV Nguyen  
Primary Examiner  
Art Unit 2625

May 22, 2007